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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,175	10/16/2003	Darwin Mitchell Hanks	10007283-3	8834

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EXAMINER

TRAN, THANG V

ART UNIT PAPER NUMBER

2653

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,175

Applicant(s)

HANKS, DARWIN MITCHELL

Examiner

Thang V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-44, 46-52, 54-57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-39 is/are allowed.
- 6) ☒ Claim(s) 40-44, 46, 47, 49-51, 54, 55, 59, 61 and 62 is/are rejected.
- 7) ☒ Claim(s) 48, 52, 56, 57 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The amendment dated 02/01/05 have been considered with the following results:

1. The indicated allowability of number of claims in a previous Office action invention is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 40 and 41 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14 of U.S. Patent No. 6,721,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitations recited in claims 40 and 41 of the present application are included in claim 1 or 14 of U.S. Patent No. 6,721,260. The only different is the wording of the claimed languages.

**Claims in the present application**

**Claims in U.S. Patent No. 6,721,260**

40

1 or 14

41

1 or 14

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 40, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Marino et al. (US 5,768,037).

Regarding claim 40, see Figs. 1, 2, 10 and 11 of Marino et al which show a drive system (see Fig. 10) for accessing a data storage medium (6) comprising: means (110) for reflecting an optical signal (100) toward the data storage medium, the reflecting means (110) responsive to an electromagnetic field generated by at least one conductive coil (55) formed on a printed circuit board (see column 3, line 55 to column 4, line 20) as recited in claim 40.

Regarding claim 41, see column 4, lines 13-20 for limitation related to conductive trace formed on the printed circuit board as recited in this claim.

Regarding claim 43, see conductive coil (coil 55 in Fig. 10) disposed outside a boundary area of the reflecting means (110).

6. Claims 46, 47, 49, 55 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Nomiyama et al (US 5,218,587).

Nomiyama et al., according to Fig. 2, 42-47, discloses an apparatus (see Fig. 42) for medium data accessing comprising: an electromagnetic element (256) for generating an electromagnetic field; and a reflector element (272 attached to a carriage s) moveable

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relative to the electromagnetic element (256) in response to the electromagnetic field and adapted to direct an optical signal (light or beam) toward a data storage medium (optical disk D), and the reflector element (272 attached to a carriage s ) is moveable in a lateral direction (see Fig. 42) relative to the electromagnetic element (256) as recited in claim 47 (see Fig. 42 for more details).

Regarding claim 46, see supporting system (see carriage portion s) for moveably supporting the reflector element relative to the electromagnetic element (256)

Regarding claim 49, see conductors (256 in Fig. 42) each extending along an axis where the reflector (272) is moved along.

Regarding claim 55, see Fig. 42 of Nomiya et al. which shows an apparatus (see Fig. 42) for medium data accessing comprising: means (256) for generating an electromagnetic field; means (272 attached to a carriage s) for directing an optical signal (light or beam) toward a data storage medium (optical disk D), and the directing means (272) moveable in a lateral direction (see Fig. 42) relative to the generating means (256) in response to the electromagnetic field.

Regarding claim 59, see Fig. 42 of Nomiya et al. which shows an apparatus (see Fig. 42) for medium data accessing comprising: electromagnetic element (256) for performing a function of generating an electromagnetic field proximate to a reflector (272 attached to a carriage s) and, (magnet 206) in response to the electromagnetic field, for performing a step of controlling the reflector (272) moveable in a lateral direction (see Fig. 42) relative to the electromagnetic element (256) to direct an optical signal (light or beam) toward a data storage medium (optical disk D) from the reflector (272).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40-44, 50, 51, 54, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Momiyama et al in view of Marino et al.

Nomiyama et al., according to Fig. 2, 42-47, discloses an apparatus comprising all features of the instant claimed invention (see rejection applied to claim 47 above) except for the use of conductive coil formed on a printed circuit board as further recited in claims 40, 41, 50, 51, 54, 61 and 62. Marino et al, according to column 3, line 55 to column 4, line 20, teaches that the conductive coil can be constructed by using conventional wound coil or replace with printed circuit coil containing circuit trace in order to minimize assembly cost. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the conventional wound coil (256) in the apparatus of Nomiyama et al with a printed circuit coil as taught by Marino et al in order to reduce manufactured or assembly cost. For limitation recited in claim 42 and 44, see circuit 293 in Fig. 43 of Momiyama et al. For limitation recited in claim 43, see conductive coil (256 in Fig. 42 of Momiyama et al) disposed outside a boundary area of the reflecting means (272).

***Allowable Subject Matter***

9. Claims 21-39 are allowed.

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10. Claims 48, 52, 56, 57 and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 21-39, 48, 52, 56, 57 and 60 are allowable over the prior art of record because the prior art of record, considered in combination or individually, fails to suggest or fairly teach a drive system or method for medium data accessing including a combination of all limitations as particularly recited in each of claims 21, 29, 36, 48, 52, 56, 57 and 60. Claims 22-28, 30-35 and 37-39 are allowable with their respective parent claim.

***Response to Arguments***

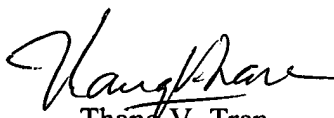
12. Applicant's arguments with respect to claimed invention have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thang V. Tran  
Primary Examiner  
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